UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,486	08/31/2000	James J. Crow	BRO039/4-001	4808

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EXAMINER
ALAM, UZMA

ART UNIT	PAPER NUMBER
2157	

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/653,486	CROW, JAMES J.
	Examiner	Art Unit	
	Uzma Alam	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>13 January 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-33</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-33</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

Response to Amendment

This action is responsive to the amendment filed on September 24, 2004. Claims 1-33

are pending. Claims 1, 11, 21, 30 and 33, all independent claims, are amended to include new

limitations. Claims 1-33 represent a method of configuring a personal computer for broadband

communications.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United
> States before the invention thereof by the applicant for patent, or on an international application by another who
> has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention
> thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

Claims 1-3, 7, 9, 9-13, 17-24 and 28-33 are rejected under 35 U.S.C. 102(e) as being

anticipated by Wang et al. US Patent No. 6,636,505. Wang teaches the invention substantially as

claimed including a method for automatically provisioning a broadband communication service

(see abstract).

As per claims 1, 11, and 21 Wang teaches the method, system and control software of

converting a personal computer for

communicating information on a broadband communication network, said personal

computer having a user and a physical location, comprising:

determining whether said physical location falls within a set of service boundaries for

said broadband communication network (checking location of client and if service is available at

that location; column 4, lines 53-60; column 5, lines 20-30; column 10, lines 63-67; column 11,

lines 1-7);

if said physical location falls within said service boundaries, electronically offering said

user access to said broadband communication network (sending client offer of broadband

service; column 5, lines 20-30; column 11, lines 7-35);

receiving from said user an electronic order accepting said offer (user responds with an

OK; column 5, lines 20-30; column 6, lines 25-32);

remotely qualifying said personal computer for said broadband communication network

by determining whether said personal computer meets predetermined acceptance criteria for use

of said broadband communication network (checking client system for compatibility with

broadband network; column 6, lines 66-67; column 7, lines 1-15, lines 33-67; column 8, lines 1-41, lines 64-67; column 9, lines 1-11); and

fulfilling said order by initiating an automation agent on said personal computer to interact with a user and thereby configure said personal computer for access to said broadband communication network (configuring client to use the broadband network/ column 5, lines 20-67; column 6, lines 1-65); and

automatically configuring an asses of said broadband communication network to communicate with said personal computer (updating the Management Information Database of the ATM when a configuration is selected by the user; column 9, lines 23-32; column 10, lines 63-37 and column 11, lines 1-34).

As per claims 2, 12, and 23 Wang teaches the conversion method, system and control software of claims 1, 11, and 21 wherein said broadband communication network is a DSL network (column 6, lines 4-12).

As per claims 3, 13, and 24 Wang teaches the conversion method, system and control software of claims 2, 12, and 23 wherein said qualifying step further comprises using a narrowband modem to contact a DSL line qualification server to test a physical line outside of said broadband communication network (column 5, lines 49-65).

As per claims 7 and 17, Wang teaches the conversion method and system of claims 1 and 11 wherein said user is selected for said offer based on preestablished criteria (column 5, lines 54-65).

As per claim 8, Wang teaches the conversion method of claim 6, wherein at least some of said criteria are stored in a subscriber profile database (column 9, lines 36-55).

As per claims 9, 19, and 28 Wang teaches the conversion method, system and control software of claims 1,11, and 22 wherein said broadband communication network is an ISDN network (the network includes a fiber optic network; column 6, lines 4-12)

As per claims 10, 20, and 29, Wang teaches conversion method, system and control software of claim 1, 11, and 22 wherein said broadband communication network is a wireless network (column 6, lines 4-12)

As per claim 18, Wang teaches conversion method of claim 17, wherein at least some of said criteria are stored in a subscriber profile database (column 9, lines 36-55).

As per claim 30, Wang teaches a method comprising:

remotely determining whether a an asset needed to communicate via a broadband communication network(checking client system for compatibility with broadband network can be configured to communicate wit ha personal computer and automatically configuring an assest

of said broadband communication network to communicate with said personal computer and

updating the Management Information Database of the ATM when a configuration is selected by

the user; column 6, lines 66-67; column 7, lines 1-15, lines 33-67; column 8, lines 1-41, lines 64-

67; column 9, lines 1-11; ; column 9, lines 23-32; column 10, lines 63-37 and column 11, lines 1-

34); and

in response to determining that said asset can be configured, initiating an automation

agent on said personal computer to configure said personal computer to communicate via said

broadband communication network (configuring client to use the broadband network/ column 5,

lines 20-67; column 6, lines 1-65).

As per claim 31, Wang teaches the method of claim 30 wherein

the remotely determining is performed in response to all electronic order for a service

provided via the broadband communication network (sending client offer of broadband service;

column 5, lines 20-42; column 11, lines 7-35).

As per claim 32, Wang teaches the method of claim 30 wherein the remotely determining

is performed in response to a narrowband connection between said personal computer and an

automation server (column 5, lines 49-65).

As per claim 33, Wang teaches Control software for configuring a personal computer for

communicating over a broadband network, said control software comprising:

a first module to determine whether an asset of said broadband communication network

needed to communicate via said broadband communication network(checking client system for

compatibility with broadband network and updating the Management Information Database of

the ATM when a configuration is selected by the user; column 6, lines 66-67; column 7, lines 1-

15, lines 33-67; column 8, lines 1-41, lines 64-67; column 9, lines 1-11; ; column 9, lines 23-32;

column 10, lines 63-37 and column 11, lines 1-34); and

a second module to configure said personal computer to communicate via said broadband

communication network can be configured to interact with said personal computer(configuring

client to use the broadband network; column 5, lines 20-67; column 6, lines 1-65).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 4-6, 8, 14-16 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Wang et al. US Patent No. 6,636,505 in view of Bahlman US Patent No. 6,684,242.

Bahlmann teaches the invention substantially as claimed including a method for preparing a

computer for service activation with a network service provider (see abstract).

As per claims 4, 14, and 25 Wang teaches the conversion method, system and control software of claims 1, 11, and 22. Wang does not explicitly disclose wherein said broadband communication network is a cable network. Bahlmann teaches a cable network. See column 3, lines 37-48. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the cable network of Bahlmann with the broadband network of Wang. A person of ordinary skill in the art would have been motivated to do this so that the network can be used with user premise equipment.

As per claims 5, 15, and 26 Wang and Bahlmann teach the conversion method, system and control software of claims 4, 14, and 25 wherein qualifying step further comprises detecting a carrier signal from said broadband communication network (Wang; column 6, lines 13-33).

As per claims 6, 16, and 27, Wang and Bahlmann teach the conversion method, system and control software of claims 5, 15, and 26 wherein said carrier signal has a signal strength and a set of error codes, and wherein said qualifying step is based at least part upon said signal strength and said error codes (Wang column 9, lines 1-11).

Response to Arguments

Applicant's arguments filed September 24, 2004 have been fully considered but they are not persuasive. The limitation of automatically configuring an asset of a broadband

communications network to communicate with said personal computer does not further limit the

invention. This asset can be any device on the network, including the modem of the personal

computer. The rejection, however, is modified to include specific portions of the Wang

reference which also teach update the MIB (Management Information Base) of the ATM.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Uzma Alam whose telephone number is (571) 272-3995. The

examiner can normally be reached on Monday-Tuesday 5:30 AM - 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the

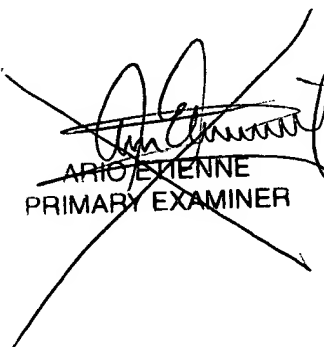organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Uzma Alam
Ua
March 14, 2006

ARIO ETIENNE
PRIMARY EXAMINER